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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,366	09/22/2000	Christopher John Ling	GB9-1999-0146US1	9751
45541	7590	02/05/2008		
HOFFMAN WARNICK & DALESSANDRO LLC			EXAMINER	
75 STATE ST			LANIER, BENJAMIN E	
14TH FLOOR				
ALBANY, NY 12207			ART UNIT	PAPER NUMBER
			2132	
			MAIL DATE	DELIVERY MODE
			02/05/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/667,366

Applicant(s)

LING, CHRISTOPHER JOHN

Examiner

Benjamin E. Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed 28 December 2007 amends claims 1, 7, 15, and 17.

Applicant's amendment has been fully considered and entered.

### ***Response to Arguments***

2. Applicant argues, "the original specification teaches that the indicator is stored directly as a result from a request and not as a result of a login." This argument is not persuasive because the cited portions of the specification makes no mention of the directness with which the claimed indicator is stored with respect to a request.

3. Applicant argues "the indicator in Shi is stored only after a user has logged in to the network." This argument is not persuasive because Shi discloses that when it is determined that a requesting user does not have a cookie stored, a login HTML form is transmitted to the user along with a cookie (i.e. same transmission)(Figure 4, 68 & Col. 8, lines 32-34).

4. Applicant argues, "in contrast to Shi, the claimed invention deals specifically with elements of web pages that are stored separately from the base web page but that are displayed on the web page in conjunction with the web page." This argument is not persuasive because Shi fully discloses that when the requested web page is transmitted to the requesting user all other separate files that make up the web page are gathered (Col. 4, line 59 - Col. 5, line 4).

### ***Specification***

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The phrase "computer readable medium," is not found to have proper

antecedent basis in the specification, however it is necessary to use this terminology in order to properly define the claim within the boundaries of statutory subject matter. In order to overcome the objection, an amendment to the specification is necessary constituting a non-exhaustive statement of what the phrase "computer readable medium" would be as it would have been known to one of ordinary skill in the art at the time of the invention, in order to verify that the term "computer readable medium," could not be taken in the context of non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims have been amended to include, "responsive directly to a request from a client for a web page hosted by a web server, storing an indicator that said client has requested a web page hosted by said web server." While the specification may disclose that an indicator/persistent client state object/cookie is stored responsive to a user request, no mention is made as to the directness of storage with respect to the request. Page 8, lines 1-15 of the specification discuss how the state object/cookie is created in response to the user request, such

that the state object/cookie will include information relevant to the request prior to be distributed to the user, and then stored.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended to include, "responsive directly to a request from a client for a web page hosted by a web server, storing an indicator that said client has requested a web page hosted by said web server," which render the claims indefinite because it is unclear how the indicator/persistent client state object/cookie can be stored before it is even created. Storage as a direct result of request would require such a scenario. Page 8, lines 1-15 of the specification discuss how the state object/cookie is created in response to the user request, such that the state object/cookie will include information relevant to the request prior to be distributed to the user, and then stored. Therefore, the claims will be treated in light of the specification, which shows that the state object/cookie is stored as a result of the user request with possible intermediate steps being performed prior to actual storage of the state object/cookie.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-9, 11-13, 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shi et al., US patent 5,875,296.

In reference to claims 1, 17:

Shi et al. discloses a method of verifying a right to use an element of a web page hosted by a web server, the method comprising the steps of:

- Responsive to a request from a client for a web page hosted by a web server, storing an indicator that said client has requested a web page hosted by said web server, where the indicator is a cookie, stored on the client side. (Column 8, lines 32-35) The process begins with the client making an HTTP request as disclosed by (Column 8, lines 14-31)
- Responsive directly to a request from a client for an element of a web page, checking for said indicator that said client has requested a web page from said web server, where in response to a client request for a webpage a test is made to see if the browser supports cookies, and if so, has a cookie previously been issued (checking said indicator that client has requested a webpage). (Column 8, lines 21-31)
- Responding to the request from the client for said element of a web page that is stored in a separate file from the web page and hosted by the web server according to the result of said checking step, where if the cookie authentication was not successful an HTML document describing the failure is returned. (Col. 4, line 59 - Col. 5, line 4 & Column 8, lines 51-60)

In reference to claim 2:

Shi et al. discloses a method as claimed in claim 1, wherein said storing step comprises:

Returning to the client a persistent client state object having an identifier therein;

And wherein said checking step comprises checking for said persistent client state object having the identifier therein returned by said client, prior to said responding step. (Column 8, lines 54-60)

In reference to claim 3:

Shi et al. discloses a method as claimed in claim 2 wherein the persistent client state object is a cookie. (Column 6, lines 49-51)

In reference to claim 4:

Shi et al. discloses a method as claimed in claim 2 wherein the persistent client state object expires after a pre-determined period of time. (Column 7, lines 15-20)

In reference to claim 5:

Shi et al. discloses a method as claimed in claim 1 wherein said storing step comprises adding an identity of said client to a table associated with said web server; (Column 8, lines 61-66)

And wherein said checking step comprises checking for client identity in said table, prior to said responding step, where the checking step uses the cookie to check for credentials. (Column 8, line 66) – (Column 9, line 13)

In reference to claim 6:

Shi et al. discloses a method as claimed in claim 1 wherein said table includes an expiry time associated with a respective client identity in said table, where the unique id stored in a cookie, is stored in a table (Column 8, lines 61-66) and where cookies have an expiry time associated with a client identity in the table (Column 7, lines 15-20)

In reference to claim 7:

Shi et al. discloses a method of verifying a right to use an element of a web page hosted by a web server, the method comprising the steps of:

- Responsive to a request from a client for an element of a web page that is stored in a separate file from the web page (Col. 4, line 59 - Col. 5, line 4), checking said request for an indicator that said request results from a client request for a web page hosting by an authorized web server, where this request initiates searching for the authentication cookie, which may or may not be included in the actual request itself (Column 9, lines 8-10) and where the cookie is matched to see if it belongs to the right domain of authorization, or an authorized web server (Column 7, lines 26-35) as part of the authentication process. The indicator having been provided to the client by the authorized web server in direct response to a request from the client for the web page hosted by the authorized web server (Col. 8, lines 14-63).
- Responsive to the presence of such an indicator, responding to the request from the client with said element of a web page, where upon authentication the web document is retrieved. (Column 9, lines 3-10)



In reference to claim 8:

Shi et al. discloses a method as claimed in claim 7 wherein said indicator comprises a Uniform Resource Locator for said web page, and said checking step comprises checking that said web page URL is from an authorized web server. (Column 7, lines 25-35, lines 51-55) & (column 8, lines 32-41)

In reference to claim 9:

Shi discloses the method as claimed in claim 7 wherein said indicator comprises a meta-tag incorporated in web pages from authorized servers, and said checking step comprises checking that said meta-tag is from an authorized web server (Col. 7, lines 44-60).

In reference to claim 11:

Shi et al. discloses a method as claimed in claim 7 operable in one of said web server or a proxy server connecting said web client to said web server, where (Figure 3) discloses the method operable in a web server connecting the web client to the web server.

In reference to claim 12:

Shi et al. discloses a method as claimed in claim 7 wherein if said checking step fails to detect said indicator, said responding step comprises returning a message for display at the client to the client, where the message is an HTML document describing the error. (Column 8, lines 51-54)

In reference to claim 13:

Shi et al. discloses a method as claimed in claim 7 wherein if said checking steps fails to detect said indicator, said responding step comprises returning a substitute element to the client, where the substitute element is an HTML document with an error message. (Column 8, lines 51-54)

In reference to claim 15:

Shi et al. discloses a method in a web client of verifying a right to use an element of a web page hosted by a web server, the method comprising the steps of:

- Responsive directly to encountering a request for an element of a web page that is stored in a separate file from the web page (Col. 4, line 59 - Col. 5, line 4), checking that said request results from a client request for a web page hosted by an authorized web server, where this request results in authenticating the client by searching for the authentication cookie, where the cookie is matched to see if it belongs to the right domain of authorization (authorization server) (Column 7, lines 26-35), and if to be valid is searched for the authentication credentials (the unique id) (Col. 8, lines 14-63 & Column 9, lines 3-10)
- Responsive to such a request, requesting said web page element from a server hosting said web page element, where upon authentication the web document is retrieved. (Column 9, lines 3-10)

The multiple dependent claim 16, is rejected for the same reasons as claims 1, 7 and 15.

In reference to claim 18:

Shi et al. discloses the method as claimed in claim 1, wherein if said checking step fails to detect said indicator, said responding step comprises returning a message for display at the client to the client, where the message is an HTML document describing the error. (Column 8, lines 51-54)

In reference to claim 19:

Shi et al. discloses the method as claimed in claim 1, wherein if said checking step fails to detect said indicator, said responding step comprises returning a substitute element to the claim, where the substitute element is an HTML document with an error message. (Column 8, lines 51-54)

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 14, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Shi et al, US patent 5,875,296.

In reference to claim 14:

Shi et al. fails to explicitly disclose a method as claimed in claim 7 wherein if said checking step fails to detect said indicator, said responding step comprises returning no response to the client.

It would have been obvious to one of ordinary skill in the art at the time of invention, to ignore requests that weren't authenticated, and return no response to the client in order to conserve bandwidth by not sending any error message.

In reference to claim 20:

Shi et al. fails to explicitly disclose a method as claimed in claim 1 wherein if said checking step fails to detect said indicator, said responding step comprises returning no response to the client.

- It would have been obvious to one of ordinary skill in the art at the time of invention, to ignore requests that weren't authenticated, and return no response to the client in order to conserve bandwidth by not sending any error message.

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shi et al, US patent 5,875,296, in view of Houston, U.S. Patent No. 6,353,929. Referring to claim 10, Shi does not specify that the URL/domain meta-data is PICS compliant. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a PICS compliant tag for the URL/domain meta-data for the cookies in Shi because PICS is the World Wide Web Consortium endorsed standard for tagging information on the Internet as taught by Houston (Col. 2, lines 27-31).

### ***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

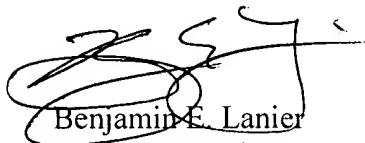
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Benjamin E. Lanier  
Primary Examiner